

REMARKS

Status of the Claims

Claims 1-29 are now present in this application. Reconsideration of this application, as amended, is respectfully requested.

Obviousness-Type Double Patenting

Claims 1 and 15-17 are provisionally rejected on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claims 21-24 of co-pending application no. 10/585,757 (hereinafter "the '757 application"). Applicants respectfully traverse the provisional rejection.

The claimed invention was made by or on behalf of YAMAGUCHI UNIVERSITY and/or NISSAN CHEMICAL INDUSTRIES, LTD., who are each parties to a **Joint Research Agreement** that was in effect on or before the date the claimed invention was made. The claimed invention was made as the result of activities undertaken within the scope of the Joint Research Agreement. As such, Applicants co-file herewith: a) a Terminal Disclaimer over the '757 application; and b) a Statement under 37 CFR 1.104(c)(4). Also, Applicants have amended the specification to refer to the Joint Research Agreement.

In legal principle, the filing of a TD simply serves the statutory function of removing the rejection of obviousness-type double patenting, and does not raise a presumption on the merits of the rejection. It is improper to view the simple expedient of "obviation" as an admission or acquiescence on the merits. *Ortho Pharmaceutical Corp. v. Smith*, 22 USPQ2d 1119, 1124 (Fed. Cir. 1992) citing *Quad Envtl. Technologies Corp. v. Union Sanitary Dist.*, 946 F.2d 870, 874, 20 USPQ2d 1392, 1394-95 (Fed. Cir. 1991).

Based on the foregoing, the obviousness-type double patenting rejection is rendered **moot**.

Allowable Subject Matter

The Examiner states that claims 1-29 are allowable. Applicants thank the Examiner for the early indication of allowable subject matter in this application.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.


In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Garth M. Dahlen, Ph.D., Esq., Reg. No. 43,575, at the telephone number of the undersigned below to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

Dated: June 3, 2010

Respectfully submitted,

By 
Gerald M. Murphy, Jr.
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GARTH M. DAHLEN
USPTO #43,575

Attachments: a) Terminal Disclaimer and b) Statement under 37 CFR 1.104(c)(4).

Docket No.: 0171-1294PUS1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Masayuki MORITA et al.

Application No.: 10/588,232

Confirmation No.: 5423

Filed: August 3, 2006

Art Unit: 1796

For: ELECTRODE FOR ENERGY STORAGE
DEVICE AND PROCESS FOR PRODUCING
THE SAME

Examiner: S. Fang

STATEMENT UNDER 37 CFR § 1.104(C)(4)

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REMARKS

Applicants note that the invention claimed in the present application and the invention disclosed and claimed in pending **reference** Application Number 10/585,757, filed January 12, 2005 were made by or on behalf of a joint research agreement as defined by 35 USC 103(c). The parties to the joint research agreement were YAMAGUCHI UNIVERSITY and NISSAN CHEMICAL INDUSTRIES, LTD. The joint research agreement was in effect on or before the date the invention claimed in the present application was made. The invention claimed in the present application was made as a result of activities undertaken within the scope of the joint research agreement.

CONCLUSION


Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Gerald M. Murphy, Jr. (Reg. No. 28,977) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated:

JUN 03 2010

Respectfully submitted,

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